

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 1, 5, 14, and 18 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-20 are now pending in this application.

The Applicant would like to thank the Examiner for the careful consideration of the claims.

Rejection of claim 5 as being indefinite.

The PTO has rejected claim 5 under 35 U.S.C. Section 112, second paragraph, as being indefinite, since it depends from itself. By way of this amendment and reply, claim 5 has been amended to now depend from claim 1.

Rejection of claims 1, 2, 8, and 18 as being anticipated by Okamoto.

The PTO has rejected claims 1, 2, 8, and 18 as being anticipated U.S. Patent 6,854,448 ("Okamoto"). For at least the following reasons, the rejection is traversed.

First, claims 1 and 18 have been amended in order to clarify a feature of the present invention, which is not disclosed by Okamoto. In the amended claims 1 and 18, a partition as a split means for dividing an inside region of the intake port into the first and second passages is disposed within an intake port defined by a cylinder head of the engine. In contrast, Okamoto teaches a dividing plate 132 disposed in an intake passage 127 of the intake pipe 128 that is connected to the engine cylinder 120 (Fig. 2 of Okamoto). Thus, Okamoto does not describe the partition disposed within the intake port that is defined by a cylinder head of the engine, as claimed in the amended claims 1 and 18. Therefore, Okamoto does not anticipate the claimed subject matter of claims 1 and 18.

Second, it is noted that the PTO has rejected claim 5-7 as being unpatentable over Okamoto by contending that "it would have been obvious to one of ordinary skill in the art to

have mounted the partition wall and control valve further downstream, with the partition being mounted in the cylinder head, since there appears to be no criticality in the claimed mounting position.” (paragraph 5 of the Office Action dated 8/11/2005). The Applicant respectfully disagrees. The guidelines for establishing a case for obviousness is found in the MPEP:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” (See MPEP 2143).

The PTO has not provided any suggestion or motivation to modify Okamoto. “The teaching or suggestion to make the claimed combination ...must...be found in the prior art, not in applicant's disclosure.” *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The PTO only asserts that it would be obvious to mount the partition wall and control valve further downstream, with the partition being mounted in the cylinder head, since there appears to be no criticality in the claimed mounting position. However, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Since there is no motivation or suggestion to modify Okamoto, as suggested by the PTO, the claims are not rendered unpatentable by the teachings of Okamoto.

Third, claim 1 includes the feature of a “gas motion control valve...having a full-closed position where the valve element fully closes the second passage of the intake port,” as seen, for example, in Figs. 1 and 3. In contrast, Okamoto does not teach a closed position where the second passage of the intake port is fully closed. Fig. 2 of Okamoto shows that air will flow through the second passage regardless of the position of the valve 131. For example, if the valve 131 is touching pipe 128, air will flow through the second passage because of the opening near reference numeral 130. If the valve 131 is parallel to the plate 132, air will flow through the second passage because of the opening near the reference numeral 129. Because Okamoto does not teach a gas motion control valve with a full-closed position where the valve element fully closes the second passage of the intake port, Okamoto

does not teach all the claimed limitations of claim 1. Therefore, Okamoto does not anticipate claim 1.

Finally, claim 18 includes the feature of a “valve means...cooperating with the split means to recirculate a part of intake air flowing toward the engine cylinder through the first passage of the intake port,” as seen, for example, in Figs. 3-4. In contrast, Okamoto provides no teaching of any recirculation. Both passages of Okamoto, as alluded to above, have air flowing through them regardless of the position of the valve 131. Thus, the claimed recirculation could not take place. Because Okamoto does not teach a valve means cooperating with the split means to recirculate a part of the intake air flowing toward the engine cylinder through the first passage of the intake port, Okamoto does not teach all the claimed limitations of claim 18. Therefore, Okamoto does not anticipate claim 18.

For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 5-7 and 20 as being unpatentable over Okamoto.

The PTO has rejected claim 5-7 and 20 as being unpatentable over Okamoto. For at least the following reasons, this rejection is traversed.

In regard to the rejection of claim 5-7, the rejection is improper because there is no motivation or suggestion to modify Okamoto, as suggested by the PTO, as presented above.

In regard to claim 20, the PTO asserts that “applicant is placed on official notice that it is well known in the art of intake passages to include ports for returning blow-by gases and it would have been obvious to one of ordinary skill in the art to have included such an arrangement in Okamoto’s intake passage so as to return blow-by gases into the combustion chamber.” (paragraph 5 of the Office Action dated 8/11/2005). The Applicant respectfully disagrees with the PTO’s use of taking official notice. According to the MPEP:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art. *In re Ahlert*, 424 F.2d at 1091, 165 USPQ at 420-21. (MPEP 2144.03).

Further, the MPEP states that:

Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002)...If such notice is taken, the basis for such reasoning must be set forth explicitly. The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. (MPEP 2144.03)

In this case, the PTO has failed to provide any prior art reference where it is well known in the art of intake passages to include ports for returning blow-by gases and has failed to provide any technical and scientific reasoning to support this conclusion. Thus, because no prior art references or technical and scientific reasoning have been presented, the PTO has improperly given official notice.

For at least these reasons, reconsideration and withdrawal of the rejection is respectfully requested.

Rejection of claims 1-20 over claims 1-18 of Arimatsu and claims 1-13 of Sakai.

The PTO has rejected claim 1-20 under the judicially created doctrine of double patenting over claims 1-18 of U.S. Patent 6,874,465 (“Arimatsu”) and over claims 1-13 of U.S. Patent 6,868,823 (“Sakai”). For at least the following reasons, this rejection is traversed.

The intake apparatus of the amended claim 1 claims a partition disposed within an intake port defined by a cylinder head of the engine and a gas motion control valve disposed at a downstream end of the intake manifold. Also, the intake apparatus of the amended claim 18 claims a split means for dividing an inside region of the intake port into first and second passages disposed within an intake port defined by a cylinder head of the engine and a valve means for controlling intake air flowing into the second passage of the intake port disposed within the intake manifold.

On the other hand, claims 1-18 of Arimatsu and claims 1-13 of Sakai describe an intake arrangement having a partition that divides the intake port into first and second passages, but do not describe a gas motion control valve as a valve means for controlling the intake air flowing into the second passage of the intake port which is disposed within the intake manifold, as claimed in the amended claims 1 and 18. Therefore, the amended claims of the present application and the claims 1-18 of Arimatsu and claim 1-3 of Sakai are not claiming common subject matter.

Therefore, reconsideration and withdrawal of the rejection is respectfully requested.

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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